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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/703,562

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William C O'Neil, Jr.

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EXAMINER

CHAMPAGNE, DONALD

ART UNIT

PAPER NUMBER

3688

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DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/703,562	Applicant(s) O'NEIL, JR. ET AL.	
	Examiner Donald L. Champagne	Art Unit 3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-8,11,13-16,24,25,29-32 and 49-56 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-8,11,13-16,24,25,29-32 and 49-56 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Specification***

1. A substitute specification excluding the claims is required pursuant to 37 CFR 1.125(a) because of numerous inconsistencies between the reference numbers in the figures and in the text. For example, Figure 1 identifies a "Money Manager 110", and it is referred to as such at least twice in the text (p. 10, lines 1 and 2), but then it is referred to erroneously as "Money Manager 100" at at least eight places (p. 12 lines 5, 24 and 27, and p. 13 lines 1, 8, 19 and 24).
2. A substitute specification must not contain new matter. The substitute specification must be submitted with markings showing all the changes relative to the immediate prior version of the specification of record. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived. An accompanying clean version (without markings) and a statement that the substitute specification contains no new matter must also be supplied. Numbering the paragraphs of the specification of record is not considered a change that must be shown.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
4. Claims 1, 4-8, 11, 13-16, 24, 25, 29-32 and 49-56 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.
5. The following limitation in every independent claim,

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“wherein said computer processor is located at location other than the location of the merchant”,

(e.g., at claim 1 lines 4-5 from the end) is new matter because the application as originally filed does not disclose that said computer processor can be located at a location other than the location of the merchant. The application discloses,

“The present invention is not limited to processors located at a particular site. Indeed, the processors may be located at a variety of sites.” (Spec. p. 4 lines 22-23)

“Site” is not expressly defined, but from the context the examiner interprets “site” to mean a physical location. Hence the application does disclose that processors may be at different physical locations, but does not disclose that “the location of the merchant” is not one of the processor locations. There are an infinite number of locations where the processors could conceivably not be. There is no basis in the original disclosure for the specific negative limitation “wherein said computer processor is located at location other than the location of the merchant” (MPEP § 2173.05(i)).

6. The following limitation in every independent claim,

“calculating a rebate on each purchase made from said at least one registered merchant using said registered debit and credit card accounts”,

(e.g., the first three lines of claim 1, limitation “c”) is not supported if this clause is intended to mean “calculating a rebate ... using said registered debit and credit card accounts”, i.e., that the credit/debit card is somehow involved in the calculation of the rebate.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1, 4-8, 11, 13-16, 24, 25, 29-32 and 49-56 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following limitation in every independent claim,

“calculating a rebate on each purchase made from said at least one registered merchant using said registered debit and credit card accounts”,

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(e.g., the first three lines of claim 1, limitation “c)”) is indefinite. The examiner interprets this clause to mean *calculating a rebate on each purchase made from said at least one registered merchant, wherein said purchase is made using said registered debit and credit card accounts*.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1, 4-8, 11, 13-16, 24, 25, 29-32 and 49-56 are rejected under 35 U.S.C. 103(a) as obvious over Lidman (US005471669A)¹ in view of official notice.

11. Lidman teaches (independent claims 1, 24, 49, 50, 53, 55 and 56) a method and a system, the method (as expressed by claim 56) comprising:

a) providing:

i) debit and credit card accounts (col. 3 line 38), which are inherently “registered” (with the credit card issuing entity),

ii) at least one higher education account (the *account 50*, col. 2 lines 41-42 and 52-53, and col. 1 lines 25-26 and 53-54),

iii) at least one registered merchant (*store 20*, col. 4 lines 21-25, with *cash register 110*, col. 2 lines 40-44), *offering coupons, matching funds* and *store promotions* (col. 1 lines 53-56, col. 2 lines 1-4 and col. 4 lines 57-60), which read on rebates,

iv) a computer processor (*microprocessors*, col. 3 line 51, in *banks 130, 131*, col. 2 lines 52-53 and *cash register 110*) connected to said at least one registered merchant (the merchant operating *cash register 110*) via a communications link (*telephone lines 122* and *bank communication system 120*, col. 2 lines 66-67);

¹ Lidman was made of record 15 December 2003.

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b) via said computer processor, monitoring sales by said at least one registered merchant via said communications link (done inherently by the card issuer for purchases by credit/debit card) and determining if said sales are consummated using said registered debit and credit card accounts (col. 3 lines 37-47);

c) via said computer processor (*cash register 110*), totaling the value of all coupons presented by a purchaser (col. 3 lines 5-6), or implementing a *matching funds program* (col. 4 lines 10-20), either of which reads on calculating a rebate on each purchase made from said at least one registered merchant, with each said purchase using said registered debit and credit card accounts (col. 3 lines 35-53), wherein said calculating step is performed by said computer processor, wherein said computer processor is configured to calculate said rebate based on an existing formula (an addition rule for the totaling at col. 3 lines 5-6 or calculating the *matching funds* using *the proportion of matching funds*, col. 4 line 14), wherein said processor then debits the account of the merchant (col. 4 lines 4-7 and 57-60); and

d) via a computer network (Fig. 1), crediting said at least one higher education account with said rebate (col. 1 lines 25-46), wherein said rebate is provided by said at least one registered merchant (col. 4 lines 57-60).

12. The following claim language is non-functional descriptive material and was not given patentable weight (MPEP § 2106.01):

“wherein said computer processor is located at location other than the location of the merchant”,

In the sense used in the patent law (35 USC 101), the location of a processor is not functional because it is neither “tied to a particular apparatus” nor “operates to change materials to ‘a different state or thing’” (*IN RE COMISKEY*, CAFC 2006-1286, September 2007).

13. Lidman does not teach, wherein said rebate ranges from 0.01% to 30% for each transaction or (claims 13 and 31) purchases made on-line. Official notice of these common knowledge or well known in the art statements were taken in the Office action mailed on 15 December 2003 (para. 17 of paper No. 6). These statements are taken to be admitted prior art

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because applicant either failed to traverse the examiner's assertion of official notice or that the traverse was inadequate. (MPEP 2144.03.C.)

14. For claims 1, 24, 49, 50, 53 and 55, no patentable weight was given to a "Rebate Network Manager" because it is non-functional descriptive material.
15. For claim 49, Lidman does not teach transferring funds from said educational account to make payments on education loans and/or debt. Lidman does teach that *account 50 can be treated as other bank account* (col. 4 lines 61-62), so it would have been obvious to "transfer funds from said educational account to make payments". No patentable weight was given to "loans and/or debt" because this or any other purpose of the payment is non-functional descriptive material. Dependent claims 51 and 52 are similarly obvious because "a second computer processor" is interpreted as any arbitrary computer processor used in the Lidman network by the *bank 150* to make said educational payments.
16. Lidman also teaches at the citations given above claims 4, 5-7, 8, 11, 14, 15 and 30 (the credit card system operator reads on a tracking entity), 25, 32 and 54 (which adds only account types, which is non-functional descriptive material).
17. Lidman also teaches at the citations given above claims 16 and 29, where the *bank 130* that is the custodian of *customer account 50* and *store account 132* reads on a registration organization, which must obviously be paid (receives a portion of said rebate).

Response to Arguments

18. Applicant's arguments filed with an amendment on 9 May 2008 have been fully considered but they are largely moot due to the new basis of rejection. The following arguments are still pertinent.
19. Applicant argues (p. 12, third bullet), that the examiner has not given adequate consideration to "findings of fact concerning secondary considerations of nonobviousness already ... made of record and ... found to overcome a previous, essentially identical rejection over Lidman and Schultz." There were four findings of fact made of record at para. 17-22 of the Office action mailed on 19 January 2007:

(1, para. 18 of the Office action) *Lidman does not teach a centrally-coordinated system.* First, further review has found this conclusion to be incorrect. Lidman teaches the use of

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credit and debit cards, which inherently provides central coordination, essentially serving the function of applicant's "Rebate Network Manager". Second, the claims are actually limited to "a computer processor located at location other than the location of the merchant", and that was not given patentable weight (para. 14 above).

(2, para. 19) *Schultz is not adequate for proving said central coordination.* This finding is moot because Schultz is no longer necessary to either provide "central coordination" or to reject the claims.

(3, para. 20) *There is a long felt need for the instant invention and it has the potential to be commercially successful.* A review of the record continues to show this to be a valid finding.

(4, para. 21) *Simpson (and implicitly other references made of record) does not teach/suggest monitoring sales by a registered merchant to determine if said sales are to a registered member.* This finding is at least partially wrong. The debit/credit card network taught by Lidman inherently monitors sales by a registered merchant (using the debit/credit card network, para. 11 above).

Hence, at best only two of the four findings support allowance. Facts in evidence have to be weighted (MPEP § 716.01(d)), and this evidence is deemed to be insufficient to overcome the instant obviousness rejection.

20. The claims are limited to "monitoring sales by at least one registered merchant" (e.g., in claim 56, limitation "b)"). Lidman inherently teaches monitoring some sales by at least one registered merchant, which reads on the claims (para. 11 above). Applicant implies (p. 23 of the 9 May 2008 filing) that the instant invention monitors all sales. The examiner could not find support in the specification for this "all sales" interpretation. However, limiting the claims to monitoring all sales by at least one registered merchant would overcome the rejection of record. Applicant is cautioned that such an amendment must be accompanied by a credible citation to support in the specification for the amendment. Failure to do so could lead to a rejection under 35 USC 112, 1st para. for new matter.
21. The applicant is cautioned that the prior art does teach and justify monitoring all sales (Savar, US pat. 4,727,243, Abstract). Hence an amendment to monitoring all sales would not necessarily lead to allowance.

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22. Applicant argues (pp.27-28) that rebates within the range claimed (para. 13 above) are not common knowledge. Official notice of this fact was taken in December 2003. The examiner cannot find evidence that applicant has previously traversed the finding. Since it is now after final rejection, the present traverse is not seasonal (MPEP § 716.01(A)).
23. Date of Invention – It is noted that applicant has declared the date of invention to be before 3 August 1999 (declaration of Michael Thompson dated 30 October 2007).

Conclusion

24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 9:30 AM to 8 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.
25. The examiner's supervisor, James W. Myhre, can be reached on 571-272-6722. The fax phone number for all *formal* fax communications is 571-273-8300.
26. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).
27. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

25 July 2008

/Donald L. Champagne/
Primary Examiner, Art Unit 3688